



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Salvador L. Arias et al.
SERIAL NO.: 08/994,531 GROUP ART UNIT: 2711
FILED: December 19, 1997 EXAMINER: C. Grant
FOR: ASYMMETRICAL DATA
COMMUNICATION SYSTEM

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Assistant Commissioner for
Patents
Box AF
Washington, DC 20231

ATTORNEY DOCKET NO.: 36968/172908

I hereby certify that this correspondence is being deposited with the United States Postal Service as certified first class mail in an envelope addressed to Assistant Commissioner for Patents, Box AF, Washington, DC 20231, on April 14, 2000.

Sharon J. Jenkins

DATE: April 14, 2000

RESPONSE UNDER RULE 116

Sir:

This document is a full and timely response to the final Office Action of December 1, 1999, which also includes a Petition for Extension of Time for Two Months, and a check in the amount of \$380.00 to cover fee. Reexamination and reconsideration are respectfully requested. Entry of the amendment is warranted since no new issues are presented, the response requires no additional search by the Examiner, and it adopts suggestions made by the Examiner during a telephonic interview.

The Examiner is thanked for the courtesy of our telephonic interview on February 1, 2000. The Examiner explained that the declaration must contain language indicating that the invention was reduced to practice in the United States, NAFTA or a WTO member country, and should state that exhibits submitted are photocopies of original

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drawings or sketches. The Examiner also indicated that the statement that "testing was performed prior to March 16, 1995" is acceptable to establish that the invention was reduced to practice.

The affidavit submitted by the Applicant under 37 C.F.R. 1.131 was rejected by the Examiner as being ineffective to overcome the Kostreski (5,563,892) reference. Specifically, the Examiner contended that the declaration was defective because the Applicant did not state at least one of three ways in which an applicant can establish prior invention of the claimed subject matter as required under 37 C.F.R. 1.31(b). This rejection of the 37 C.F.R. 1.131 affidavit is traversed. The affidavit submitted with the amendment dated June 28, 1999 implies from the statements and submitted exhibits that the claimed invention was reduced to practice prior to March 16, 1995. This is especially true in light of the Examiners reference to paragraph 6 of the amendment. The Declaration demonstrated that an actual reduction to practice occurred prior to the Kostreski filing date.

The Examiner also rejected the Applicant's affidavit stating that the evidence submitted does not appear to be original sketches, blueprints, photographs, lab notebook entries or photocopies thereof. MPEP 715.07 states in part that,

[e]vidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. **For example**, the allegations of fact might be supported by submitting as evidence one or more of the following: (A) attached sketches; (B) attached blueprints; (C) attached photographs; (D) attached reproductions of notebook entries; an accompanying model; attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon.

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Emphasis added.

First, 37 C.F.R. 1.131 requires satisfactory evidence that shows the priority of invention, which can be done by any satisfactory evidence of the facts. MPEP 715.07. Second, any evidence in the form of exhibits can be used to establish priority of invention. Id. The fact that MPEP 715.07 states “for example” when presenting the list of types of evidence that can be used expressly shows that the list is not all inclusive. For at least the above stated reasons, the Examiner’s rejection stating that the Applicant’s exhibits are not conforming under MPEP 715.07 should be withdrawn.

Finally, the Examiner stated that the exhibits containing diagrams and photographs indicate and illustrate testing and use of equipment prior to March 16, 1995. However, the Examiner stated the exhibits themselves do not appear to be the original or actual documents used in the testing and use of the equipment. Documents presented as exhibits to an affidavit under 37 C.F.R. 1.131(b) may be original drawings or records, or photocopies thereof and must accompany and form part of the affidavit or declaration. Since the exhibits attached to the Applicant’s affidavit are photocopies of original drawings or records, the Examiner’s rejection under 37 C.F.R. 1.131(b) should be withdrawn. Nonetheless, the affidavit under Rule 131 has been revised to include a statement that the exhibits are photocopies of original documents that existed prior to March 16, 1995.

In light of the above arguments and the revised Declaration submitted by the Applicant to expressly include language indicating that the testing and reduction to practice

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occurred in the United States and that the exhibits are photocopies of original documents, the Examiner should withdraw his objection to the sufficiency of the submitted Declaration. Furthermore, the affidavit was amended to only include the above mentioned express language. No new matter has been included in the revised Declaration.

Claim 1 has been rejected under § 102(e) as being anticipated by U.S. Patent No. 5,563,892 to Kostreski et al. ("Kostreski"). Claims 2 to 6, 7 to 15, and 32 to 34 have been rejected as being obvious over Kostreski in view of U.S. Patent No. 5,600,364 to Hendricks and claim 6 has been rejected as being obvious over Kostreski in view of some allegedly admitted prior art.

All of the rejections issued in the Office Action therefore have the Kostreski patent as the primary reference. The Examiner relied upon the Kostreski patent under §102(e) on the basis that the patent application forming the basis for the Kostreski patent was filed before the instant patent application. As demonstrated below, the Kostreski patent does not qualify as prior art under §102(e) since the date of invention for this application is prior to the filing date of the Kostreski patent application. Consequently, the rejections based on Kostreski should be withdrawn and the Examiner is respectfully requested to allow claims 1 to 15 and 32 to 34.

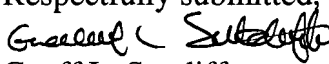
A revised Declaration under 37 C.F.R. § 131 is being submitted with this Amendment, and this Declaration establishes that the invention was completed and reduced to practice prior to the filing date for the Kostreski patent application, in other words prior to

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March 16, 1995. The Declaration demonstrates that an actual reduction to practice occurred prior to the Kostreski filing date in the United States. For instance, the Exhibits to the Declaration establishes that testing occurred in the United States prior to Kostreski's effective filing date, and, moreover, that system level testing occurred in the United States prior to Kostreski's effective filing date. The Exhibit illustrates LMDS System Diagram, the actual LMDS node transceiver used in testing, the actual LMDS CPE transceiver used in testing, architecture for the LMDS node station equipment, and architecture for the LMDS CPE station equipment. Moreover, the Exhibits contain test results which confirmed technical assumptions about the feasibility of the invention. The Declaration therefore establishes that the Kostreski patent is not prior art under § 102(e) and that the rejections must be withdrawn.

Claims 1 to 15 and 32 to 47 are now in condition for allowance. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is encouraged to telephone the undersigned at (404) 815-6530.

Please charge any additional fees or credit any overpayment to Deposit Order
Account No. 11-0855.

Respectfully submitted,

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